



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,993	06/02/1999	STEPHEN LESLIE TYLER	169.1322	9943
5514	7590	03/17/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WALLERSON, MARK E	
			ART UNIT	PAPER NUMBER

2626

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,993

Applicant(s)

TYLER, STEPHEN LESLIE

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 25-42, 44-50 and 53-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-13, 25-36 and 48-50 is/are allowed.
- 6) ☐ Claim(s) 37-42, 44-47 and 53-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2626

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 7/15/04.
2. This application has been reconsidered. Claims 1-13, 25-42, 44-50, and 53-57 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 53 – 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 53 and 55, the phrase, “limits use of said application program” is unclear.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 37, 38, 39, 40, 41, 42, 44, 45, 46, 47, and 53-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Brobst et al (Brobst) (U.S. 6,061,700).

With respect to claims 37, 40, 41, 42, 46, and 47, Brobst discloses a method of printing one or more printable pages of data originating from one or more web-sites (column 3, lines 12-40) by selecting one or more printable pages of data from one or more web-sites that a user has previously been connected to (which reads on a list of URLs from a web browser's historic memory) (column 5, lines 21-32); determining whether the number of printable pages of data selected from the one or more web-sites exceeds a predetermined number of printable pages of data (which reads on determining the depth into the nesting tree which the formatting mechanism reaches to find related URLs, wherein the depth refers to the links (or web-sites) in each page) (column 5, lines 49-67); and printing one or more of the selected printable pages of data up to said predetermined number of printable pages of data, if it is determined that the number of selected printable pages of data exceeds said predetermined number of printable pages of data, and otherwise printing each of the selected printable pages of data (which reads on gathering/collecting and selecting for printing only the related web pages that are within a predetermined nesting level) (column 5, lines 11-67 and column 6, lines 1-64).

Art Unit: 2626

With respect to claims 38, 44, Brobst discloses the web-sites are accessed using a Web browser (column 2, lines 59-66).

With regard to claims 39, 45, Brobst discloses prompting the user to identify particular printable pages of data desired to be printed (column 5, lines 42-67 and column 6, lines 43-53).

With respect to claims 53 and 55 (as best understood by the Examiner), Brobst discloses the one or more printable pages of data are selected and printed using an application program (web browser) (column 1, lines 23-42 and column 2, line 59 to column 3, line 30), such that the predetermined number of printable pages of data limits use of said application program (column 5, lines 42-67 (selecting web pages up to a definitive level obviously limits use of the browser since an exhaustive number of levels or pages would not be retrieved).

With respect to claims 54, 56, and 57, Brobst discloses the predetermined number of printable pages of data are defined by a provider (user) of said application program (column 11, lines 21-26 and column 5, lines 42-67).

Allowable Subject Matter

7. Claims 1-13, 25-36 and 48-50 are allowed.

Response to Arguments

8. Applicant's arguments with respect to claims 37-42 and 44-47 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2626


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER

A large, stylized handwritten signature in black ink, likely belonging to Mark E. Wallerson, is positioned to the right of the printed name and title.